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EXAMINER

OMGBA, E

ART UNIT PAPER NUMBER

3726

DATE MAILED: 05/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/413,993

Applicant(s)  
Landry et al.

Examiner  
Essama Omgba

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3726



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) 6-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Oct 7, 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a method for coating the outer surface of a length of coiled pipe with insulating material, classified in class 29, subclass 527.2.
  - II. Claims 6-9, drawn to an insulating material, classified in class 524.
  - III. Claims 10-15, drawn to a method of installing an insulated tubular member on a sea floor, classified in class 405.
  - IV. Claims 16-18, drawn to a system for applying an insulation compound to a tubular member, classified in class 29, subclass 33 R.
  - V. Claim 19, drawn to a method of glueing a first syntactic foam material with a second syntactic foam material with an insulation material, classified in class 156.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product such as one that does not require acrylic resins and ceramic particles.

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3. Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a series of laser controlled hydraulic cylinders and an induction heat coil member are not required for the combination. The subcombination has separate utility such as in the automotive industry.

4. Inventions I and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as one that does not require a first and second vessels and a control means.

5. Inventions I and V are related as process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP § 806.05(I)).

6. Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product

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as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product such as one that does not require separate mixtures combined at a ratio of 1 to 1 by volume.

7. Inventions IV and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require separate mixtures combined at a ratio of 1 to 1 by volume. The subcombination has separate utility such as use in the automotive industry.

8. Inventions II and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as coating a pipe.

9. Inventions III and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice

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another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced with another materially different apparatus such as one that does not require first and second vessels.

10. Inventions III and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require a mixture being at 1 to 1 volume ratio. The subcombination has separate utility such as in the automotive industry.

11. Inventions V and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as one that does not require a first heater means.

12. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper.

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13. During a telephone conversation with Mr. Gregory Smith on 05/14/2001 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

### *Drawings*

15. The drawings filed on 10/07/1999 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948.

### *Specification*

16. The disclosure is objected to because of the following informalities: "it's" in line 15 of page 3 should read --its--, "was" in line 4 of page 5 should read --were--, "any where" in line 17 of page 11 should read --anywhere--, the "second retort or mold casing" and the "second retort"

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in lines 11 and 16 respectively on page 24 have been referenced by reference numeral 44 when reference numeral 44 in fact designates rollers throughout the drawings and the specification.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

19. Claim 1 recites the limitations "the outer surface" and "the insulated covered pipe" in lines 1 and 13 respectively. There is insufficient antecedent basis for these limitations in the claim. It is not clear what is meant by "laser controlled hydraulic cylinders" in line 6 of claim 1. It is the examiner's understanding that the hydraulic cylinders are actuated by the control panel in response to inputs from the laser beams.

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Recalde (US Patent 4,721,410) in view of Russmann et al. (US Patent 6,153,270).

With regards to claim 1, Recalde discloses a method made up of repetitive series of steps for coating an outer surface of a length of coiled pipe with insulating material made up of epoxy resins mixture, with appropriate curing devices provide, wherein the method comprises unrolling the pipe 50 from a pipe reel 20, straightening the pipe with a straightening apparatus 424, advancing the straightened pipe into a heated mold, coating the pipe with the insulating material and releasing the insulated coated pipe from the mold, see column 1, lines 50-54, column 2, lines 6-15, column 5, lines 3-11, column 6, lines 14-19. Recalde does not disclose the pipe being heated with an induction heat coil member prior to being straightened or prior to being coated with the insulating material, and using laser beams in controlling hydraulic cylinders used in straightening the pipe. However Russmann et al. teaches the use of inductive heating for heating a metallic work piece prior to coating it with an organic coating, see column 2, lines 11-20 and column 3, lines 21-25. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have heated the pipe of Recalde by inductive heating prior to coating it with the insulation material, in light of the teachings of Russmann et al., in order to realize an economic and energy saving operation and obtain the necessary reaction temperature to achieve a good quality of coating. Applicant should note that Official notice is taken that it is known to heat

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an unreeled pipe prior to straightening it in order to anneal the pipe and facilitate the straightening operation and that it is known to use laser beams to check the straightness of a pipe.

For claims 2 and 5, see column 2, lines 21-23, column 5, lines 1-22 and column 6, lines 14-16 of Recalde.

For claim 3, see figure 3, element 338 of Recalde.

For claim 4, Applicant should note that Official notice is taken that molds made up of bottom hinged halves are old and well known to those skilled in the art. It is the examiner's understanding that the essence of Applicant invention resides in the particular composition of the insulating material. However this is not readily apparent from the method claims.

### ***References***

22. The prior art references listed on the enclosed PTO-892, but not used in a rejection of the claims, are pertinent to Applicant's disclosure.

### ***Contact Information***

23. Official documents related to the instant application may be submitted to the Technology Center 3700 mail center by facsimile at (703) 305-3579/3580. Should Applicant desire to submit a DRAFT response to the Examiner by facsimile transmission, then Applicant should contact the Examiner at the number below for instructions concerning the transmission of DRAFT documents. Applicant is reminded to clearly mark any facsimile transmission as "DRAFT" if it is not to be considered as an official response.

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24. Any inquiry concerning this communication should be directed to Examiner  
Essama Omgba at telephone number (703) 305-2915.

eo  
May 18, 2001

J. C. A. R. R.  
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